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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,584	05/16/2001	Thomas M. Collins	2280.2700	1405
26211	7590	10/12/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/855,584	Applicant(s) COLLINS ET AL.	
	Examiner Alicia Baturay	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 6, 17, 23, 29 and 40-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 17, 23, 29 and 40-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to the amendment filed 31 July 2006.
2. Claims 1-5, 7-16, 18-22, 24-28 and 30-39 were cancelled.
3. Claims 40-51 were added.
4. Claims 6, 17, 23, 29 and 40-51 are pending in this Office Action.

### ***Response to Amendment***

5. Applicant's amendments and arguments with respect to claims 6, 17, 23 and 29 and new claims 40-51 filed on 31 July 2006 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 17, 23, 29, 40-42, 44-46 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (U.S. 6,311,210) and further in view of Redpath (U.S. 6,256,672).

Foladare teaches the invention substantially as claimed including when a sending party wishes to send an electronic mail message to a receiving party, the sending party creates the electronic mail message along with any attachments using his/her user device and sends the electronic mail message to the centralized electronic mail apparatus. The centralized electronic mail apparatus further determines the portions of the electronic mail message that are to be sent to each of the electronic mail receiving devices (see Abstract).

8. With respect to claim 6, Foladare teaches an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:

Enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Foladare, col. 3, lines 5-14); enable each recipient to create and edit a recipient profile, the profile including the recipient's preferences with regard to receipt of prospective attachments (Foldare, col. 6, 1 lines 8-17); and transmit the message over a network to the plurality of recipients wherein (Foladare, col. 3, lines 5-14), the transmission to the at least one recipient of the plurality of recipients to receive the message without the attachment uses less bandwidth of the network than the transmission to the at

least one recipient of the plurality of recipients to receive the message with the attachment (Foldare, col. 6, lines 21-40).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

9. With respect to claim 40, Foldare teaches the invention described in claim 6, including the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies information about prospective attachments that the recipient is unable, or does not wish, to receive (Foldare, col. 6, lines 8-17 and lines 21-40).

10. With respect to claim 41, Foldare teaches the invention described in claim 40, including the article including instructions that, when executed by the machine, cause the machine to prevent recipient by the recipient of the prospective attachments that the recipient's profile

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indicates the recipient is unable, or does not wish, to receive (Foldare, col. 6, lines 8-17 and lines 21-40).

11. With respect to claim 42, Foldare teaches the invention described in claim 41, including the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies the recipient is not to receive attachments larger than a specified size (Foldare, col. 6, lines 8-17 and lines 21-40).

12. Claims 17, 23, 29, 44-46 and 48-50 do not teach or define any new limitations above claims 6 and 40-42 and therefore are rejected for similar reasons.

13. Claims 43, 47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foldare in view of Redpath and further in view of Ulrich et al. (U.S. 6,052,735).

14. With respect to claim 43, Foldare teaches the invention described in claim 41, including an article comprising a machine-readable medium storing machine-readable instructions that, when executed by the machine, cause the machine to perform the following operations:

Enable a sender to input a message; enable the sender to append an attachment to the message; enable the sender to designate at least one recipient of a plurality of recipients to receive the message and the attachment (Foldare, col. 3, lines 5-14); enable each recipient to create and edit a recipient profile, the profile including the recipient's preferences with regard

to receipt of prospective attachments (Foldare, col. 6, l lines 8-17); and transmit the message over a network to the plurality of recipients wherein (Foldare, col. 3, lines 5-14), the transmission to the at least one recipient of the plurality of recipients to receive the message without the attachment uses less bandwidth of the network than the transmission to the at least one recipient of the plurality of recipients to receive the message with the attachment (Foldare, col. 6, lines 21-40).

Foldare does not explicitly teach the sender designating a recipient to receive the message without the attachment.

However, Redpath teaches enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Redpath, Fig. 3, element 230; col. 3, lines 19-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Foldare in view of Redpath in order to enable the sender designating a recipient to receive the message without the attachment. One would be motivated to do so in order to facilitate not wasting any storage space or download time sending redundant/unneeded materials.

The combination of Foldare and Redpath does not explicitly teach a profile that specifies that a recipient is not to receive attachments during a particular time.

However, Ulrich teaches the article including instructions that, when executed by the machine, cause the machine to enable the recipient to create and edit a profile that specifies the recipient is not to receive attachments during a particular time frame (Ulrich, col. 13, lines 12-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Foldare and Redpath in view of Ulrich in order to enable a profile that specifies that a recipient is not to receive attachments during a particular time. One would be motivated to do so in order to allow the user of a mobile device to dynamically retrieve individual electronic mail message attachments on a per message basis.

15. Claims 47 and 51 do not teach or define any new limitations above claim 43 and therefore are rejected for similar reasons.



*Response to Arguments*

16. Applicant's arguments filed 31 July 2006 have been fully considered, but they are not persuasive for the reasons set forth below.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay  
October 3, 2006

  
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